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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/539,096	03/30/2000	Joseph F. Fitzpatrick	7175/60314	7874

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Richard D Conard
Barnes & Thornburg
1313 Merchant Bank Bldg
11 S Meridian Street
Indianapolis, IN 46204

EXAMINER	
HOEKSTRA, JEFFREY GERBEN	
ART UNIT	PAPER NUMBER
3736	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/539,096	FITZPATRICK ET AL.	
	Examiner	Art Unit	
	Jeffrey G. Hoekstra	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5,6,9,11,13,15 and 17-30* is/are rejected.

7)☒ Claim(s) *3,4,7,8,10,12,14,16 and 31-34* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice of Amendment

1. In response to the amendment filed on 04/05/2006 and 04/13/2006, amendment(s) to the specification and amended claim(s) 1, 9, 10, 12, 14, 16-20, 22, 23, and 29 is/are acknowledged. The current rejections and objections of the claim(s) 1-34 are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

Reissue Applications

2. This application is objected to under 37 CFR 1.172(a) as lacking the proper and explicit written (and signed) consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01. The consent of the assignee is objected to because the assignee providing the consent of March 30, 2000 does not appear to be the current assignee of record.

3. A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action. See MPEP § 1410.01 for the preferred format of the consent of the assignee. Applicant's attention is directed to form PTO/SB/96 included with this correspondence.

4. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that *all errors* that are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414. The reissue declaration

fails to indicate the residence and mailing address for each inventor. An address is provided for each inventor; however, the Declaration fails to indicate what these addresses represent.

5. Claims 1-34 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

Response to Amendment

6. The affidavit under 37 CFR 1.132 filed 04/05/2006 is insufficient to overcome the rejection of claims 1-34 based upon 35 U.S.C. 251 or to overcome the objection under 37 CFR 1.172(a) as set forth in the last Office action because:

- it fails to contain a statement that **all** errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant,
- it fails to separately indicate both the residence and the mailing address for each inventor or properly identify the mailing address is the residence, and
- it fails to contain the explicit written consent of the current assignee.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 5, 6, 9, 11, 13, 15 and 21-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Koch ('529). Koch teaches a method and apparatus for monitoring body functions, specifically skin temperature. The apparatus includes a housing (2) and first and second temperature sensors (5,6) received by and spaced apart in the housing in proximity to each other and adapted for contact with generally the same area of skin on an infant. The first and second temperature sensors (5,6) generate first and second temperature (body function) signals. A circuit (12) is coupled to the first sensor and the second sensor and processes and compares the temperature (body function) signals. A plurality of indicators (13,14,17,18,21) are provided that communicate with the circuit (12). A first indicator (13,14) is capable of providing an indication of the temperature or rate of change in temperature sensed by the first and second sensors. A second indicator (14) is capable of providing an indication of the difference between the sensed signals. Additional indicators (17,18,21) are provided that are capable of providing an indication when a difference between the sensed signals exceed a predetermined threshold that may indicate a difference in the proximity of a sensor to the skin, failure of a sensor, or measurement error.

9. Claims 17-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Stillman et al. ('149). Stillman et al. teach a method and apparatus for monitoring body functions, and is capable of providing an indication of temperature at a skin surface. The apparatus includes a housing (10') mounted by first and second temperature sensors (18,22) spaced apart in the housing in proximity to each other and adapted for

contact with generally the same area of skin on a subject. The first and second temperature sensors (18,22) generate first and second temperature signals. A circuit is coupled to the first sensor and the second sensor and processes and compares the temperature signals. A plurality of indicators are provided at a computer (40) that communicate with the circuit. A first indicator is capable of providing an indication of the temperature or rate of change in temperature sensed by at least one of the first and second sensors. A second indicator is capable of providing when an error signal when the difference between the sensed signals exceed a predetermined threshold.

Allowable Subject Matter

10. Claims 3, 4, 7, 8, 10, 12, 14, 16 and 31-34 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims, and a new Declaration and Consent of Assignee were submitted to overcome the defects and objections set forth in this Office action.

Response to Arguments

11. Applicant's arguments filed 04/05/2006 and 04/13/2006 have been fully considered but they are not persuasive. Applicant argues:

(a) that for claims 1, 5, 9, 21, and 29, Koch does not disclose, teach, or fairly suggest detecting a difference between the rate of change of the first temperature signal and the rate of change of the second temperature signal which exceeds a predetermined threshold representing a difference in the proximity of the first

temperature sensor to the skin and the proximity of the second temperature sensor to the skin (see page 19 filed 04/05/2006) and

(b) for claims 17, 20, 21, and 29, Stillman does not disclose, teach, or fairly suggest (i) a method of producing a skin temperature comprising placing at least two spaced apart temperature sensors adjacent the same area of skin, (ii) a second indicator that indicates that the at least two spaced apart temperature sensors are not measuring the temperature of the same skin area, (iii) a body function measuring apparatus comprising first and second sensors positioned to detect the body function, or (iv) a body function apparatus comprising a circuit comparing the rate of change of the first signal to the rate of change of the second signal.

12. The Examiner disagrees, maintains the anticipatory rejections of claims 1, 2, 5, 6, 9, 11, 13, 15, and 21-30 under Koch and of claims 17-30 under Stillman as broadly structurally claimed, and notes the following:

13. In response to applicant's argument (a) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., claim 19) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

14. In response to applicant's argument that (a) for claims 1, 5, 21, and 29 Koch does not disclose, teach, or fairly suggest detecting a difference between the rate of change of the first temperature signal and the rate of change of the second temperature signal which exceeds a predetermined threshold representing a difference in the

proximity of the first temperature sensor to the skin and the proximity of the second temperature sensor to the skin and (b,ii) Stillman does not disclose, teach, or fairly suggest a second indicator that indicates that the at least two spaced apart temperature sensors are not measuring the temperature of the same skin area, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The Examiner notes as stated above, specifically addressing claims 1, 5 and 20, the applied references are capable of the claimed limitations.

15. In response to applicant's arguments (b,i), (b,iii), and (b,iv), the recitation of "producing a skin temperature, comprising:" and/or "a body function measuring apparatus comprising:" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571) 272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JH

PTO/SB/96 (09-06)
Approved for use through 03/31/2007. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: _____

Application No./Patent No.: _____ Filed/Issue Date: _____

Entitled:

_____, a _____
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☐ the assignee of the entire right, title, and interest; or

2. ☐ an assignee of less than the entire right, title and interest
(The extent (by percentage) of its ownership interest is _____%)

in the patent application/patent identified above by virtue of either:

A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (*i.e.*, a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

_____	_____
Signature	Date
_____	_____
Printed or Typed Name	Telephone Number
_____	
Title	

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.